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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/568,430

10/20/2006

Heinz Rupp

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CLARK & BRODY

1090 VERMONT AVENUE, NW

SUITE 250

WASHINGTON, DC 20005

EXAMINER

TANNER, JOCELYN C

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/568,430	<b>Applicant(s)</b> RUPP ET AL.	
	<b>Examiner</b> JOCELIN C. TANNER	<b>Art Unit</b> 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/20/2006</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1, 4, 5, 8-10 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fleener et al. (US PGPub No. 2004/0127767A1) in view of Garibaldi et al. (US Patent No. 6,902,528).**

3. Regarding claim 1, Fleener et al. discloses an apparatus including a guide device (100), at least one penetrating element (12) that is selectively advanceable, retractable and rotatable by a control unit (106), a suction that must be created by a vacuum source, a suction head (40) at least one recess (60) having a lateral aperture, and a display unit (200)[0014, 0018, 0020, 0041, 0044, 0045, 0048]. However, Fleener et al. fails to provide an attachment detection system.

Garibaldi et al. teaches a flexible tube (22) connected to a computer (28) for processing and displaying an image on a display (30) and an "attachment detection system" for remotely determining the orientation of the medical device through the use of an optic sensor and an ultrasonic sensor (column 4, lines 49-53, column 6, lines 22-26, Fig. 1).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the device of Fleener et al. with an

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attachment detection system, as taught by Garibaldi et al., to determine the orientation of the medical device.

4. Regarding claim 4, Garibaldi et al. teaches an optic sensor (column 6, lines 23-25).

5. Regarding claim 5, Fleener et al. discloses an endoscope (100) that may be provided with a light source [0045].

6. Regarding claim 8, Fleener et al. discloses a display unit (200) that emits optical signals as the display means [0045].

7. Regarding claim 9, Garibaldi et al. teaches adjustable signals (column 7, lines 10-30).

8. Regarding claim 10, Fleener et al. discloses a recess (60) having a lateral aperture wherein tissue has sufficient space to be aspirated [0041, 0043, 0049].

9. Regarding claim 12, the combination of Fleener et al. and Garibaldi et al. discloses the claimed invention except for a recess having the dimensions of 8.5mm long, 4mm wide and 3mm deep. It would have been an obvious matter of design choice to have a recess having the dimensions of 8.5mm long, 4mm wide and 3mm deep, since applicant has not disclosed that having a recess with the dimensions of 8.5mm long, 4mm wide and 3mm deep solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with a recess having any length, width and depth as long as it does not compromise the structural integrity of the device and allows a medical instrument to access and manipulate tissue.

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Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided a recess having the dimensions of 8.5mm long, 4mm wide and 3mm deep, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges of dimensions involves only routine skill in the art. In re Aller, 105 USPQ 233.

10. Regarding claim **13**, Fleener et al. discloses a needle (12) as a penetrating element [0041].

11. Regarding claim **14**, Fleener et al. discloses a puncture or manipulation that is conducted outside the recess (60) [0046, Fig. 3a].

12. Regarding claim **15**, the combination of Fleener et al. and Garibaldi et al. discloses a guide device having multiple lumens (108) to guide an element (12) to puncture and manipulate tissue and a suction head (40) that can be repeatedly detached from the guide device ([0040, 0045], Fleener et al.), and a control unit that is separate from the device and that drives element (column 3, lines 25-32, column 6, lines 15-17, Garibaldi et al.).

**13. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fleener et al. (US PGPub No. 2004/0127767A1) in view of Garibaldi et al. (US Patent No. 6,902,528) and further in view of Doi et al. (US Patent No. 4,971,034).**

14. Regarding claim **2**, the combination of Fleener et al. and Garibaldi et al. discloses all of the limitations previously discussed except for a pressure detector.

Doi et al. teaches a detector used to measure a change in pressure (column 4, lines 32-37).

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a pressure detector to the device of the combination of Fleener et al. and Garibaldi et al., as taught by Doi et al., to detect and control the air supply within a body cavity.

15. Regarding claim 3, Doi et al. teaches a pressure sensor (29) used to detect a change in pressure (column 10, lines 32-37).

16. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fleener et al. (US PGPub No. 2004/0127767A1) in view of Garibaldi et al. (US Patent No. 6,902,528) and further in view of Silverstein et al. (US Patent No. 4,646,722).

17. Regarding claim 6, the combination of Fleener et al. and Garibaldi et al. discloses all of the limitations previously discussed except for an electrical detector.

Silverstein et al. teaches an endoscope having electrical sensors (column 9, lines 1-4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the combination of Fleener et al. and Garibaldi et al. with an electrical detector, as taught by Silverstein et al., to detect electrical signals of tissues.

18. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fleener et al. (US PGPub No. 2004/0127767A1) in view of Garibaldi et al. (US Patent No. 6,902,528) and further in view of Silverstein et al. (US Patent No.

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**4,646,722), as applied to claim 6 above, and further in view of Kimura et al. (US Patent No. 5,335,662).**

19. Regarding claim 7, the combination of Fleener et al. and Garibaldi et al. discloses all of the limitations previously discussed except for an ultrasonic sensor used as an acoustic detector.

Kimura et al. teaches an endoscopic device wherein an ultrasonic vibrator creates an echo from a portion varied in acoustic impedance and is displayed as an ultrasonic image on a monitor (column 19, lines 65-67, column 20, lines 1-27).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the combination of Fleener et al., Garibaldi et al. and Silverstein et al. with an ultrasonic sensor used as an acoustic detector, as taught by Kimura et al., to receive detailed information about a diseased body part.

**20. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fleener et al. (US PGPub No. 2004/0127767A1) in view of Garibaldi et al. (US Patent No. 6,902,528) and further in view of Hamilton (US Patent No. 6,383,198).**

21. Regarding claim 11, the combination of Fleener et al. and Garibaldi et al. discloses all of the limitations previously discussed except for a tapered vacuum duct within the guide device.

Hamilton teaches a vacuum duct (32) within a guide device (10) that tapers in a funnel shape toward the vacuum aperture whereby the more pronounced vacuum is located at the vacuum aperture site (column 4, lines 65-67, column 6, lines 5-14, Fig. 3).

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the device of the combination of Fleener et al. and Garibaldi et al. with a tapered vacuum duct, as taught by Hamilton, to provide a secured and controlled area for a vacuum.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOCELIN C. TANNER whose telephone number is (571)270-5202. The examiner can normally be reached on Monday through Thursday between 9am and 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jocelin C. Tanner/  
3/23/2009  
Examiner, Art Unit 3731

/Anhtuan T. Nguyen/  
Supervisory Patent Examiner, Art Unit 3731  
3/26/09